

## REMARKS

In the Office Action mailed August 13, 2004, the Examiner rejected all pending claims 10, 11, 13 & 14. Claims 10, 11, 13 and 14 have been amended. Support for the amended claims can be found throughout the specification, for example, at page 14, lines 18-21, page 19, line 11 – page 20, line 19, page 21, lines 2-12, page 28, line 22 – page 30, line 3, and page 37, line 20 – page 39, line 10. Claim 15 has been added and recites no new matter. Support for claim 15 can be found throughout the specification. Thus, claims 10, 11, 13, 14, and 15 are pending in the application. The Examiner's rejections are traversed below.

### **REJECTION UNDER 35 U.S.C. §103**

At item 4 of the outstanding Office Action, claims 10-11 and 13-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,591,289, issued to Britton (hereinafter Britton), in view of U.S. Patent No. 6,178,430, issued to Cohen *et al.* (hereinafter Cohen). The Examiner has alleged that Britton teaches all steps of claims 10-11 and 13-14 as written before Applicants amendments, except “discussion request step of requesting a discussion participant as the user to discuss and discussion step of allowing the discussion participant to discuss.” See Office Action, at page 3.

Britton discloses a method of delivering formatted electronic documents over a communications network. According to Britton, the document is “created upon request and immediately converted into a predetermined file format prior to delivery.” See Britton, column 1, lines 18-24. In particular, in Britton, a server computer is connected to a client computer via the Internet, and the client computer submits a request for the document by selecting a hypertext link, which points to a file including script commands for instructing the server computer. The server computer extracts information from the data source, thereby preparing the formatted document. The output is then transmitted to the client computer as an attachment via an electronic mail, for example. See Britton, column 3, line 56 to column 4, line 13.

The present invention, as defined by newly amended claims 10-11 and 13-14, is directed toward a digital document discussion method in which a discussion requester creates a document to be discussed using document templates. The discussion document is then sent to a discussion participant along with a discussion request to allow discussion of the document by the participant. The participant then transmits a discussion reply. See Figure 22. In at least one embodiment, “material information” associated with the discussion document can be searched and provided to the discussion participant. See Specification, page 21, lines 8-12. See also Specification, page 11, line 24 - page 12, line 1.

Applicants submit that newly amended claims 10-11 and 13-14 are patentable over Britton in view of Cohen. In particular, Applicants submit that Britton fails to teach or suggest a “discussion document creation step” in which a “discussion document based on the template” is created, as recited in the pending claims. Britton also does not teach or suggest the “document storage step,” the “template providing step,” the “discussion request step,” the “search step,” or the “material information providing step.”

Rather, Britton merely teaches preparation of a formatted document. Unlike in the present invention as defined by the pending claims, Britton does not teach “a discussion document” creation step. Britton suggests that the document is merely a list of items which a customer has purchased from a vendor. See Britton, column 1, line 26 – column 2, line 12.

Moreover, in the present invention, the discussion document is created by the discussion requestor. As described above, the discussion participant receives the discussion document. In Britton, the server computer generates a document, and the document is accessed by the client computer. Unlike in the present invention, in Britton, the *computer that receives the document*, namely the client computer, selects the hypertext link pointing to the template. Britton does not teach or suggest, “a template providing step of *providing a template* corresponding to a document to be discussed. . . to a first client *at the discussion requestor* [emphasis added],” that is, *the computer that generates the document*, as recited in the above-identified claims.

In addition, in Britton, the document to be sent to the client computer is searched for by the server computer. Thus, Britton does not teach or suggest the steps of searching “material information” and providing “the material information,” as recited in the language in the claims, as Britton merely performs a search for the document itself, not “material information.” See Britton, column 9, lines 18-26 and column 10, lines 1-37.

Likewise, Cohen offers no teaching or suggestion of “a template providing step of providing a template *corresponding to a document to be discussed* . . .to a first client at the discussion requestor.” Cohen discloses an automated information technology standards management system where an auto-notification process informs the users of a pending conference, for example, that they are requested to attend, as disclosed at column 5, lines 15-38 of Cohen. Thus, users are simply notified of a pending conference, that is, the auto-notification merely serves as an alarm to the users. As Cohen does not teach or suggest a discussion document, as recited in the pending claims, it also does not teach or suggest a template providing step of providing a template corresponding to a document to be discussed. See Cohen, column 5, lines 15-37. See also FIG. 10. As the auto-notification merely serves as an

alarm, Cohen also does not teach requesting the discussion of the discussion document, as recited by the claims. In other words, there is no teaching or suggestion of creating a discussion document in Cohen. Therefore, Cohen does not teach or suggest requesting of discussion of a discussion document.

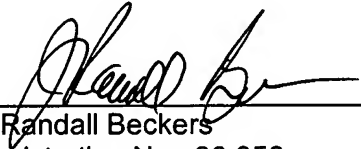
In light of the foregoing, Applicants submit that there is nothing in Britton, Cohen, or in the references as a whole that would have rendered the subject matter of the pending claims obvious. It follows that the claims are properly allowable.

An early Notice of Allowance is requested. If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the USPTO is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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